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FACSIMILE TRANSMISSION

DATE: April 26, 2005  
TO: EXAMINER MINH CHAU NGUYEN  
FACSIMILE NO.: 703-872-9306  
FROM: John G. Posa  
PAGES TRANSMITTED (INCLUDING COVER SHEET): 6  
ORIGINAL DOCUMENTS WILL \_\_\_\_ / WILL NOT  X  FOLLOW BY MAIL  
RE: SN 09/989,942  
MESSAGE:

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<b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b>		Docket No. <b>AIM-10302/29</b>	
Applicant(s): <b>Borenstein</b>			
Application No. <b>09/989,942</b>	Filing Date <b>Nov. 21, 2001</b>	Examiner <b>M. Nguyen</b>	Group Art Unit <b>2145</b>
Invention: <b>INTELLIGENT CACHING ROUTERS</b>			
<p>I hereby certify that this _____ <u>Response to Office Action</u></p> <p style="text-align: center;"><small>(Identify type of correspondence)</small></p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703/872-9306</u> )</p> <p>on _____ <u>April 26, 2005</u></p> <p style="text-align: center;"><small>(Date)</small></p> <div style="text-align: right; margin-top: 100px;"> <p><b>Sheryl L. Hammer</b></p> <p style="text-align: center;"><small>(Typed or Printed Name of Person Signing Certificate)</small></p>  <p style="text-align: center;"><small>(Signature)</small></p> </div>			
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NO. 263

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APR 26 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Borenstein

Serial No.: 09/989,942

Group No.: 2145

Filed: Nov. 21, 2001

Examiner: M. Nguyen

For: INTELLIGENT CACHING ROUTERS

RESPONSE TO OFFICE ACTION

Mail Stop AMENDMENT  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed January 26, 2005, the Examiner's attention is directed to the following remarks.

The claims of this application are being submitted in unamended form for reconsideration by the Examiner.

The Examiner cites U.S. Patent No. 6,304,915 (referred to henceforth as "the '915 patent") as anticipating claims 1-4, 9-14, 16, and 25. However, anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, *each and every element* of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

In this case, the cited patent fails to disclose at least one limitation of claim 1, namely, the step which reads "if so: processing that transaction locally and returning a response directly to the client." Although the Examiner argues that the '915 patent teaches this step referring to col. 15, lines 11-30; col. 16, lines 1-13; and col. 20, lines 5-7, Applicant disagrees. Rather, it is Applicant's position that the '915 patent makes no mention of a direct return of a response to the client.

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According to the instant invention, a "gateway interface" (to use the terminology of the '915 patent) steps in and functions as a surrogate for the network service in the case of network disruptions. It does this to provide an "always available" service for the client application, regardless of the availability of the network and server. The '915 patent is concerned with a different scenario, namely, providing the server with an always-available mechanism for making information available to clients whether or not the client is currently available on the network.

In contrast, the instant application is concerned with providing continuous availability of an application-specific subset of network services to a simple or "thin" client application. The '915 patent is concerned with allowing a payment gateway to collect all information regarding payments from a client and pass that on to a payment system, perhaps (though not explicit) queuing such information when the payment system is unavailable.

Moreover, the intended architecture of the cited prior art is different. The '915 patent talks specifically about gateways, specifically "a gateway between a network application and a host system utilizing a gateway administrative interface" (p. 17, Claim 1). The term "gateway interface" generally refers to an intermediate network interface connecting the open Internet with a separately administered private network. This is indeed the standard usage in payment systems; most payment processors provide a payment gateway to the Internet, to limit the exposure of their internal networks to outsiders. As such, the '915 patent pertains directly to how to build and deploy such a payment gateway.

Applicant's invention is based upon a rather different architecture: A client-side device, called an intelligent caching router, is designed to permit the client to execute critical functions even in the event that the entire Internet becomes unavailable. The '915 patent describes a device that allows a plurality of clients to gateway to a more protected payment network. Applicant's invention describes a device that allows a single client site to function independent of a larger distributed application service - one that includes not just payment functionality but also point-of-sale, gift card, and potentially many other features. The '915 patent describes a gateway architecture that "proxies" complex payment system functions for a plurality of client browser devices. Applicant describes a caching router that provides a "surrogate" for browser interfaces dealing with complex network services, and allows those services to continue even if the network itself is not currently available.

The Examiner's statement (in page 2 of the 1/19 action, paragraph 2) that "[t]he consumer's

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desktop can be interpreted as a locally caching" is also misguided. The '915 patent does not support this reading, as it describes no provision by which transactions will be queued on the desktop for later completion when network services become available. Quite the contrary, in Applicant's system, the transaction will later be completed, even if the desktop on which the browser running is physically turned off, powered down, or crashes. The caching functions in the payment gateway of the '915 patent are intended to provide smoother accounting, explanation, and interpretation of payment events in the event that the remote payment service is unavailable, but to do this it depends on functioning connectivity between the client site and the payment gateway itself, which does not generally reside at the client's site and is thus itself vulnerable to disruption by interrupted connectivity.

Regarding the rejections to the claims on obviousness grounds over the '915 patent in combination with other references, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there are no references from the prior art in support of these combinations and, even is so combined, Applicant's invention would not result for the reason set forth above.

Referring to the Carlson reference, in particular, (US Patent 6,845,503), it is worth noting that this patent deals with reloading application logic (specifically class definitions) in order to perform updates that could not be performed due to network outages. However, that is not the technique that Applicant uses to perform updates and maintain transaction processing capability across network outages.

Applicant's invention makes no attempt to repair network outages or update program logic because of such outages. In the instant case, the maintenance of such transaction information is entirely independent from other mechanisms that are used, when the network is fully available, to synchronize the application logic on the server and the caching router. Rather, the transactions themselves are

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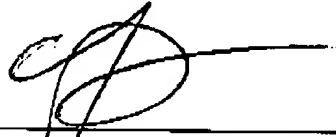
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actually executed locally, on the caching router, and then updated to the remote server after connectivity is re-established.

Based upon the foregoing comments, Applicant believes all claims continue to be in condition for allowance. Questions regarding this application may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

Respectfully submitted,



By: \_\_\_\_\_

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Dated: April 26, 2005

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